



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/333,565 | 06/21/1999 | NICHOLAS STEIGELMAN | 034297-031 | 4249 |

7590 09/16/2003

Robert E. Krebs
Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640

EXAMINER

HAROLD, JEFFEREY F

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 09/16/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/333,565

Applicant(s)

STEIGELMAN ET AL.

Examiner

Jefferey F. Harold

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

CONSULTATION with ATTORNEY

2. Authorization for this examiner's amendment was given in a telephone interview with J. Davis Gilmer on September 4, 2003.

AMENDMENT to APPLICATION

3. The application has been amended as follows:

(a) Regarding **claim 1**, line 4

"ports" has been changed to -port—

(b) Regarding claim 1, line 9

"can be alternately sent across the telephone" has been deleted.

(c) Regarding claim 6, line 1 "car" has been changed to -card--.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. ***Claims 1 and 3*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (United States Patent 5,583,922), hereinafter referenced as Davis in view of legal precedence-rearrangement of parts (MPEP 2144.04 VI C).

Regarding **claim 1**, Davis discloses a telecommunication system for automatic switching between voice and data communication. In addition, Davis discloses data circuit terminating equipment (DCE)(14), which reads on claimed "shell", having an inherent port to connect to telephone line (16), as disclosed at column 16, lines 32-43 and exhibited in figure 7;

DCE (14) containing relay switch (220), which reads on claimed "interconnection logic" operably connected to the inherent port and a wire (11) to connect to the telephone (12), as disclosed at column 16, lines 32-53 and exhibited in figure 7;

a modem (222), which reads on claimed "networking card" in the DCE for connecting to a processor (10), which reads on claimed "personal computer", the modem (222) being operably connected to relay switch (220), wherein digital data from the modem (222) and voice data from the telephone (12) can be alternatively sent across the telephone line (16), as disclosed at column 16, line 12 through column 17, line 60 and exhibited in figure 7, however, Davis fails to disclose wherein the DCE is

adapted to physically connect under a telephone. However, the examiner maintains that it was well known in the art to provide wherein the DCE is adapted to physically connect under a telephone, as taught by legal precedence-rearrangement of parts.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis by specifically providing wherein the DCE is adapted to physically connect under a telephone, as taught by legal precedence-rearrangement of parts, for the purpose of making better use of space via stacking of components.

Regarding **claim 3**, Davis and legal precedence-rearrangement of parts disclose everything claimed as applied above (see claim 1), in addition Davis discloses an inherent port to connect line 13 to processor (10), as exhibited in figure 7.

5. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, in view of and legal precedence-rearrangement of parts, further in view of legal precedence-changes in shape (MPEP 2144.04 IV B).

Regarding claim 2, Davis and legal precedence-rearrangement of parts disclose everything claimed as applied above (see claim 1), however, Davis fails to disclose wherein the DCE is wedge shaped. However, the examiner maintains that it was well known in the art to provide wherein the DCE is wedge shaped, as taught by legal precedence-changes in shape.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis by specifically providing wherein the DCE

is wedge shaped, as taught by legal precedence-changes in shape, for the purpose of making better use of space via stacking of components.

6. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, in view of legal precedence-rearrangement of parts, further in view of Aggus et al. (United States Patent 5,862,214), hereinafter referenced as Aggus.

Regarding **claim 5**, Davis and legal precedence-rearrangement of parts, the combination, disclose everything claimed as applied above (see claim 1), however, the combination fails to disclose wherein the shell has extensions for physically connecting to the bottom of the telephone. However, the examiner maintains that it was well known in the art to provide wherein the shell has extensions for physically connecting to the bottom of the telephone, as taught by Aggus.

In a similar field of endeavor Aggus discloses a low cost adjustable base stand. In addition, Aggus discloses wherein the base stand, which reads on claimed shell has locking apertures, which read on claimed "extensions" for physically connecting to the bottom of the telephone, as disclosed at column 3, line 14 through column 4, line 59 and exhibited in figures 1-17.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination by specifically providing wherein the shell has extensions for physically connecting to the bottom of the telephone, as taught by Aggus, for the purpose of adjusting the desired incline position of the base.

7. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, in view of legal precedence-rearrangement of parts, further in view of Goff (United States Patent 6,198,632).

Regarding **claim 6**, Davis and legal precedence-rearrangement of parts, the combination, disclose everything claimed as applied above (see claim 1), in addition Davis discloses a modem (220), which reads on claimed "network card", however, the combination fails to disclose wherein the network card is an Ethernet card. However, the examiner maintains that it was well known in the art to provide wherein network card is an Ethernet card, as taught by Goff.

In a similar field of endeavor Goff discloses a slim media jack. In addition, Goff discloses wherein the PCMCIA card comprises connections for both RJ-11 and RJ-45 (i.e. Ethernet) media. Further, Goff discloses wherein the PCMCIA card serves as a modem and an Ethernet card, as disclosed at column 4, lines 7-30 and exhibited in figure 3.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination by specifically providing wherein the network card is an Ethernet card, as taught by Goff, for the increasing the number of media interfaces that a PCMCIA card can accommodate.

8. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, in view of legal precedence-rearrangement of parts, the combination, in view of well know prior art (MPEP 2144.03).

Regarding **claim 4**, the combination discloses everything claimed, as applied above, (see claim 1), in addition, the combination discloses wherein the DCE, which reads on claimed "shell" is connected to processor, which reads on claimed "computer" via wire 13. Further the DCE provides electronics to connect to the processor via the wire, however, the combination fails to disclose a wireless connection to the PC. However, the examiner takes official notice of the fact that it was well known in the art to provide wireless connection.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination by specifically providing a wireless connection, for the purpose of untethered access.

Response to Arguments

9. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

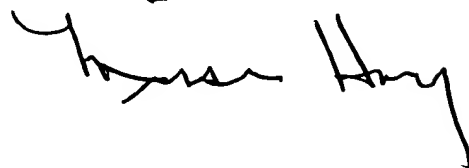
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is (703) 306-5836. The examiner can normally be reached on Monday-Friday 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


JFH



**MINSUN OH HARVEY
PRIMARY EXAMINER**